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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,067	11/29/2001	Hiroyuki Hirata	YK1-0081	4811
23413	7590	01/07/2005	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,067

Applicant(s)

HIRATA ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-9,26 and 29-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9,26 and 29-50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/30/2004 has been entered.

Response to Amendment

Amendment received on 11/30/2004 is acknowledged and entered. **Claims 3, 4, 10-25 and 27-28** have been canceled. **Claim 1** has been amended. New **claims 29-50** have been added. **Claims 1, 2, 5-9, 26 and 29-50** are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al. WO 00/30338 (Stern) in view of Official Notice and further in view of Manico et al. (U. S. 6,373,551) (Manico).

Claims 1 and 29, Stern, which appears to be published on May 25, 2000, teaches a system and method for electronic film processing, comprising a photo storage module for storing data by a user, and a server for receiving and processing said data, further comprising:

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reading data stored in the photo storage module (user device) (P. 2, L. 16; P. 48, L. 20-21); said data including a unique module identifier, user name and address, user Internet Service Provider (ISP) and user ISP proprietary information (e.g., user name and password) (P. 33, L. 31 – P. 34, L. 10);

storing said data in a server computer connected to said network in association with said unique data (P. 33, line 31 – P. 35, L. 22);

transmitting said data to a terminal connected to said network when the user accesses said server computer from the terminal using said unique data (P. 2, L. 16; P. 33, L. 31 – P. 34).

Stern further teaches, that said user ISP data specifies that AOL is a user ISP (P. 35, L. 11-22).

Stern does not specifically teach that said data stored in the photo storage module includes at least a portion of a web page address. Also, Stern does not specifically teach "*returning*" of the user device.

Official Notice is taken that it is well known that AOL web address is www.aol.com (see an Internet print-out of AOL web site, May 8, 1998).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stern to include that said assigned unique user information (address) includes at least a portion of a web page address, because it would advantageously help user to memorize said web page address, thereby simplify the interaction with the system.

Manico teaches a system and method for communication of digital images generated from photographic film, wherein a one-time use camera is employed, thereby obviously indicating returning said one-time camera for developing images (C. 2, L. 51).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stern to incorporate the "*returning*" feature, as indicated in Manico, because it would advantageously allow the customers, who do not have access to web connection, to maintain and retrieve their digital images via the Internet.

Claim 2, Manico teach said system and method, wherein said address is previously provided in a form, which is visible to the user (imprinted on a tear off tab of

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the package) (C. 3, L. 13-16, 44-46). The motivation to combine Stern in view of Official Notice with Manico would be to advantageously help to memorize said web address, thereby simplify the interaction with the system.

Claim 5, Stern teaches said system and method, wherein said address is generated from information associated with the user (P. 32, L. 8 – P. 35, L. 22).

Claim 6, Manico teaches said system and method, wherein said address is URL (C. 3, L. 13-15, 56-59; C. 5, L. 43-45, 65-67). The motivation to combine Stern in view of in view of Official Notice with Manico would be to allow the customers to access their digital images via the Internet.

Claim 7, Stern teaches said system and method, wherein said data is transmitted to the server computer via said network and is stored on said server computer (P. 33, line 31 – P. 35, L. 22).

Claim 8, Stern teaches that user terminal is a computer (P. 34, L. 5-10).

Claims 9 and 38, Stern teaches that said data includes image data and/or voice data (P. 44, L. 21-23).

Claim 30, Stern teaches storing said data in a server computer connected to said network in association with said unique data (P. 33, line 31 – P. 35, L. 22).

Claim 31, Stern teaches that source of images is a digital camera (P. 2, L. 16).

Claim 32, Manico teaches generating images by a one-time use camera (C. 2, L. 51), thereby obviously indicating that said camera operates for a limited period of time.

The motivation to combine Stern in view of in view of Official Notice with Manico would be to advantageously allow the customer to take digital pictures without purchasing expensive digital camera.

Claim 33, Manico teaches that said address is imprinted on a tear off tab of the camera package (C. 3, L. 13-16, 44-46). The motivation to combine Stern in view of in view of Official Notice with Manico would be to advantageously help to memorize said web address, thereby simplify the interaction with the system.

Claim 34, Manico teaches attaching said address by a removable label (sticker) (C. 3, L. 26-27). The motivation to combine Stern in view of in view of Official Notice

with Manico would be to advantageously help to memorize said web address, thereby simplify the interaction with the system.

Claim 35, Stern teaches said system, wherein said data, including unique information relating to the address, is stored in said photo storage module (P. 33, L. 31 – P. 34, L. 10).

Claim 36, Stern teaches said system, wherein said data, including unique information relating to the address, is stored in said photo storage module (P. 33, L. 31 – P. 34, L. 10). Information as to *wherein the unique address is based on a serial number of the digital camera* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 36 are disclosed in Stern in view of Manico as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 37, Stern teaches said system, wherein said data, including unique information relating to the address, is stored in said photo storage module (P. 33, L. 31 – P. 34, L. 10), wherein said address is based on information associated with the user (said information, associated with the user, includes AOL as user ISP (P. 35, L. 11-22), thereby obviously indicating that said unique data includes at least a portion of a web page address (www.aol.com)).

Claim 39, Stern teaches sending said unique information relating to the address to the server (P. 33, line 31 – P. 35, L. 22).

Claim 40, Manico teach said system and method, wherein said address is imprinted on a tear off tab of the package (C. 3, L. 13-16, 44-46). The motivation to combine Stern in view of in view of Official Notice with Manico would be to allow the

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customers, not having access to web connection, to maintain and retrieve their digital images via the Internet.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Official Notice, further in view of Manico and further in view of Tanaka (US 6,476,929).

Claim 26. Stern in view of Official Notice and Manico teach all the limitations of claim 26, including storing the unique address or unique data in a memory of the user device, except that *said unique data is stored in a root directory area in the memory of said device.*

Tanaka teaches a method and system for creating a memory structure on a memory card using a digital camera having an order-file creating function, said structure including image files and order files, said order files are for specifying image files to be printed; wherein the order files have been registered in a root directory (C. 7, L. 13-15; 45-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stern in view of in view of Official Notice and Manico to include that said unique data is stored in a root directory area in the memory of said device, as disclosed in Tanaka, because it would advantageously provide an efficient data structure on said memory of said device, which allow to replace only image files (selected to be printed) and keep said unique data intact.

Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Official Notice.

Claim 41. Stern teaches said system and method for electronic film processing, comprising:

receiving a device form a user, said device having image data stored therein (P. 10, L. 6-23);

associating unique user information with the unique storage module unit identifier purchased by the user (assigning a unique address to the user), wherein said unique user information includes AOL as user ISP (P. 35, L. 11-22).

displaying said image data on a predetermined web site (P. 33, L. 11-12).

Stern does not specifically teach that said assigned unique user information (address) includes at least a portion of a web page address.

Official Notice is taken that it is well known that AOL web address is www.aol.com (see an Internet print-out of AOL web site, May 8, 1998).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stern to include that said assigned unique user information (address) includes at least a portion of a web page address, because it would advantageously help user to memorize said web page address, thereby simplify the interaction with the system.

Claim 42. Stern teaches displaying said image data on a predetermined web site (P. 33, L. 11-12).

Claim 43. Stern teaches assigning an identification number to a user (P. 35, L. 3-4).

Claim 44. Stern teaches that a source of images is a digital camera (P. 2, L. 16).

Claims 45-47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Official Notice and further in view of McIntyre et al. (US 2004/0172646 A1).

Claim 45. Stern in view of Official Notice teaches all the limitations of claim 45, except *lending* said camera to the user.

McIntyre teaches a method and system for providing image services to a customer, including leasing an electronic camera to the customer [0148]; and digitally printing images produced by the camera upon return [0144]; [0151].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stern in view of Official Notice to include leasing a digital

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camera to the customer, as disclosed in McIntyre, because it would advantageously allow the customer to take digital pictures without purchasing said camera, thereby save funds.

Claim 46. Stern in view of Official Notice teaches displaying said image data on a predetermined web site (P. 33, L. 11-12), thereby obviously indicating providing the web page address to the user.

Claim 47. McIntyre teaches that said electronic camera is adapted to capture an audio signal [0084]. The motivation to combine Stern in view of Official Notice with McIntyre would be to provide users with ability to attach memorable comments to their images.

Claim 50. Stern teaches that the user can select images to be transmitted to a web site (P. 32, L. 8-14; P. 38, L. 13).

Claims 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Official Notice, further in view of McIntyre and further in view of Waites (US 6,788,769).

Claim 48. Stern in view of Official and McIntyre teach all the limitations of claim 48, except *providing text converted from the voice data on the web page*.

Waites teaches an Internet directory system and method, wherein, if a user desires to create a voice message for his/her business web page listing, the user is able to input a voice message, which can be stored as an audio file and may be converted to text and placed in the web site (C. 13, L. 46-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stern and McIntyre to include providing text converted from the voice data on the web page, as disclosed in Waites, because it would advantageously allow customers to add memorable comments to the images which have been posted on the web site.

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Claim 49. Waites teaches that said voice message could be stored as an audio file that will be played whenever the user's web page is displayed in a browser (C. 13, L. 42-45). The motivation to combine Stern and McIntyre with Waites would be to allow customers to greet visitors of their web site in their own voice, therefore make browsing through their digital images more attractive to the visitors.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 5-9, 26 and 29-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306

[Official communications; including

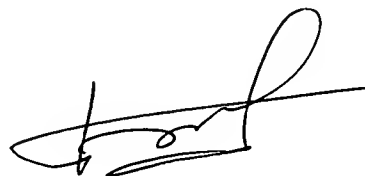
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
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A handwritten signature in black ink, appearing to read 'Igor Borissov', with a large, stylized loop at the end.

IB

12/30/2004